

REMARKS

In the Office Action mailed November 20, 2003, Claims 1-7, 9 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,714,428 issued to Le-Khac et al. The Examiner made those rejections FINAL.

Applicants confirm the correctness of the Examiner's presumption at page 3 of the instant Office Action regarding ownership of the presently claimed subject matter.

Rejections under 35 U.S.C. §103(a)

Claims 1-7, 9 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,714,428 issued to Le-Khac et al. Applicants respectfully disagree with the Examiner's contention regarding Le-Khac et al.

The Examiner contends at the paragraph spanning pages 3-4 of the instant Office Action that,

The suggestion or motivation, as clearly stated in the previous office action, comes from the reference itself, which specifically discloses polymers having molecular weights that completely embrace those claimed by applicants. Accordingly, the teaching that the polymers being claimed by applicants are clearly function (sic) in the claimed catalyst is explicitly disclosed by the reference which therefore provides explicit motivation for the selection thereof.

The only portions of the Le-Khac et al. reference which describe the functionalized polymers and provide the molecular weights thereof are reproduced below for the Examiner's convenience.

In other preferred catalysts of the invention, the functionalized polymer is selected from the group consisting of polyesters, polycarbonates, oxazoline polymers, polyalkylenimines, maleic acid and maleic anhydride copolymers, hydroxyethyl cellulose, starches, and polyacetals. (col. 4, line 66 to col. 5, line 4)

The molecular weight of the functionalized polymer can vary over a fairly wide range. Preferably, the number average molecular weight is within the range of about 300 to about 500,000; a more preferred range is from about 500 to about 50,000. (col. 5, lines 19-23)

As Applicants are unable to determine which portions of the above-reproduced passages from Le Khac et al. the Examiner believes "explicitly" disclose the instantly claimed aliphatic polycarbonate with a molecular weight below 12,000 and/or those portions of the reference which provide "explicit" motivation or suggestion to one of ordinary skill in the art to make such selections, they ask the Examiner's assistance in specifically identify said portions.

Applicants note that Le Khac et al. provide a laundry list of nine (9) classes of functionalized polymers (one of which is merely denominated "polycarbonates") and provide a preferred molecular weight range of virtually 500,000 and further note that nowhere in Le Khac et al. is there exemplified such a polycarbonate as instantly claimed. The Examiner's attention is directed to *Fujikawa v. Wattanasin* 39 USPQ2d 1895, 1905 (Fed. Cir. 1996), wherein the court stated,

Clearly, however, just because a moiety is listed as one possible choice for one position does not mean there is *ipsis verbis* support for every species or sub-genus that chooses that moiety. Were this the case, a "laundry list" disclosure of every possible moiety for every possible position would constitute a written description of every species in the genus. This cannot be because such a disclosure would not "reasonably lead" those skilled in the art to any particular species.

Applicants assert that one of ordinary skill is left to select from the myriads of possibilities encompassed by the broad disclosures of Le Khac et al. with no guide indicating or directing that this particular selection should be made rather than any of the many others which could also be made. Applicants further contend that given the unpredictable nature of the catalyst art, undue experimentation would be required.

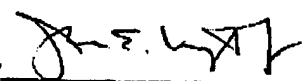
Therefore, Applicants contend that nothing in the teaching of Le-Khac et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 1-7, 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,714,428 issued to Le-Khac et al.

CONCLUSION

Applicants made no claim amendments as they believe the pending claims to be in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-7, 9 and 10. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is invited to contact the Applicants' attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

By



John E. Mrozinski, Jr.
Attorney for Applicants
Reg. No. 46,179

Bayer Polymers LLC
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
(412) 777-3024
FACSIMILE PHONE NUMBER:
(412) 777-3902
lo/MROZINSKI/jem082

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